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 Washington, D.C. 20231

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PRAVEL HEWITT KIMBALL & KRIEGER
 1177 W LOOP SOUTH
 10TH FLOOR
 HOUSTON, TX 77027-9095

APR 17 2000

**SPECIAL PROGRAMS OFFICE
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In re Application of :
 Paul L. Pool et al : DECISION GRANTING
 Application No. 09/517,383 : PETITION
 Filed: March 26, 1998 :
 Attorney Docket No. D98020US :

This is a decision on the petition filed August 13, 1999, requesting that a divisional Continued Prosecution Application (CPA) allegedly filed on March 26, 1998 based on prior application No. 08/694,397, be treated as a divisional application under 37 CFR 1.53(b), rather than under 37 CFR 1.53(d), and be accorded a filing date of March 26, 1998.

Found among the papers accompanying the present petition is a copy of the divisional CPA request allegedly filed on March 26, 1998 indicating a correspondence address unchanged from that specified in prior application No. 08/694,397. Although the present petition is signed by the same registered practitioner whose signature appears on the copy of the divisional CPA request allegedly filed on March 26, 1998, the present petition suggests a new address for the registered practitioner.

Notwithstanding the above, a review of the present petition and all accompanying papers shows that **no change of correspondence address has been filed**. This decision is being mailed to the correspondence address designated in the prior application. In addition, a copy of this decision is being mailed to that address which the present petition suggests is the registered practitioner's new address.

Furthermore, **no power of attorney has been filed** for a divisional application based upon prior application No. 08/694,397. Therefore, in accordance with 37 CFR 1.33(a) and MPEP 403 *all further communications from the Office will be mailed to the post office address of the first inventor named in the copy of the prior declaration provided with the present petition, until an attorney is appointed or a proper change of correspondence address is filed.*

Petitioners allege that the original CPA request was filed in the U.S. Patent and Trademark Office (Office) on March 26, 1998, and

subsequently misplaced in the Office. In support, the petition is accompanied by a copy of petitioners' postcard receipt acknowledging receipt in the Office on March 26, 1998 of, inter alia, a "CPA Request Transmittal" (identified by attorney docket No. D98020US), a preliminary amendment, and a \$395.00 check for the corresponding filing fee.

A review of the file of prior application No. 08/694,397 reveals that a divisional CPA request identified by attorney docket No. D98020US (hereafter, "divisional CPA request") cannot be located. However, the postcard evidence is convincing that the divisional CPA request was deposited on March 26, 1998, and subsequently misplaced in the Office. Although a complete specification and drawings did not accompany the divisional CPA request, the petition states that "[T]he application was meant to be filed under 37 CFR 1.53(b)."

Further review of the file of prior application No. 08/694,397 reveals that a request for a continuation CPA identified by attorney docket No. A96006US (hereafter, "continuation CPA request") based on prior application No. 08/694,397 was properly filed on March 26, 1998. The file also shows that the continuation CPA request has been entered in the file of prior application No. 08/694,397 and the express abandonment of the prior application has been recognized pursuant to 37 CFR 1.53(d)(2)(v). Only one CPA may be pending at one time based on the same prior nonprovisional application. See Changes to Patent Practice and Procedure; Training and Implementation Guide, Question and Answer 26 (December 1997). The continuation CPA request was accepted by the PTO as a proper CPA. Therefore, the divisional CPA request deposited on March 26, 1998, cannot be processed as a proper CPA.

The present petition filed by facsimile on August 13, 1999 was accompanied by, inter alia, a copy of the specification, drawings, and declaration from the prior application. Because those application papers were transmitted by facsimile, they are improper for an application under 37 CFR 1.53(b). See 37 CFR 1.6(d). On March 2, 2000, in a telephone communication from PTO Legal Advisor James Engel, a replacement copy of the application papers transmitted by facsimile on August 13, 1999 was requested. In response, on March 3, 2000, petitioners supplied a replacement copy of those application papers by mail.

In order to correct petitioners' filing error, on petition under 37 CFR 1.53(e), the divisional CPA request will be treated as a divisional application under 37 CFR 1.53(b) with a filing date of March 26, 1998.

The petition is granted. The \$130.00 petition fee has been charged to deposit account No. 50-0259 as authorized in the petition.

The divisional application under 37 CFR 1.53(b) has been assigned application No. 09/517,383 using the application papers supplied on March 3, 2000 for examination purposes. The petition and all accompanying papers filed by facsimile on August 13, 1999 has been placed in the file of application No. 09/517,383 as well. All further correspondence concerning the divisional application filed on March 26, 1998, should be directed to application No. 09/517,383.

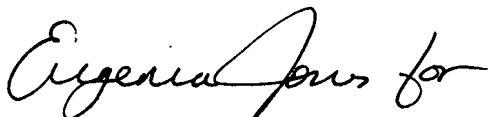
A \$65.00 surcharge set forth in 37 CFR 1.16(e) for a small entity is required for the declaration filed with the present petition on August 13, 1999 (after the filing date of the above-identified application).

Accordingly, the \$65.00 surcharge set forth in 37 CFR 1.16(e) for a small entity will be charged to applicant's deposit account No. 50-0259, as authorized in the March 26, 1998 divisional application filing.

After mailing of this decision, PTO records will be corrected to show that one of the two \$395.00 filing fees paid on March 26, 1998, and the \$130.00 petition fee paid on August 13, 1999, were paid in application No. 09/517,383, not in application No. 08/694,397.

The application will then be forwarded to Initial Patent Examination Division for further processing as a divisional application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d), with a filing date of March 26, 1998, using the application papers supplied on March 3, 2000.

Any inquiries related to this decision should be directed to Legal Advisor James Engel at (703) 308-5106.



Fred Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

JJE

cc: Albert B. Kimball, Jr.
BRACEWELL & PATTERSON
711 Louisiana, Suite 2900
Houston, Texas 77002